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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/509,358 | 09/28/2004 | Masao Komai | KOMAI5 | 2011 |

1444 7590 10/31/2005
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EXAMINER

KOEHLER, ROBERT R

ART UNIT PAPER NUMBER

1775

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/509,358 | Applicant(s) KOMAI ET AL. | |
| | Examiner Robert R. Koehler | Art Unit 1775 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

RRK.
10-26-05

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>09282004; 03292005</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Specification

The abstract of the disclosure is objected to because **(a)** the proper units for surface area are not stated in line 7 of the abstract and **(b)** the mole ratio given in line 5 of the abstract should state "lithium hydroxide" instead of "lithium silicate." The Examiner notes that "lithium silicate" is prepared by mixing particular molar ratios of silicic acid or silicate with lithium hydroxide. See lines 5 to 11 on page 3 of the specification and claim 1. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102/ § 103(a)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Evaluations of the level of ordinary skill in the art requires consideration of such factors as various prior art approaches, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, and failure of others.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or admissions are considered to reasonably reflect this level of skill.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,169,916 (Tsutsui, et al.).

Tsutsui, et al. discloses a method of coating a steel sheet with a solution that contains at least one or more of water soluble or water dispersible lithium silicates which are prepared from silicic acid or a silicate and a lithium salt such as lithium hydroxide. Tsutsui, et al. prefers that the lithium silicate is water soluble or dispersible and is prepared from a mixture of silicic acid or silicate and a lithium salt in a molar ratio of 20:1 to 1:1. The patent mentions the usage of a lithium silicate solution having a concentration in the range of from 2 to 250 g/l, and the thickness of a treated lithium silicate film is mainly controlled by the concentration of the lithium silicate solution. Hence, the lithium silicate coating becomes thicker in proportion to the increasing concentration of the lithium silicate solution. Tsutsui, et al. states that the application of a lithium compound onto a steel substrate produces a strong coating film which enhances the forming operation of a steel sheet. Hence, Tsutsui, et al. discloses a useful property of lubrication by solid lithium silicate films for the forming operations of steel sheets. See line 16 in column 2 to line 10 in column 3, lines 27 to 35 in column 3, and lines 1 to 13 in column 4. Although Tsutsui, et al. is silent as to the usage of solid lithium silicate films on a bearing seal made from surface-treated steel sheet, this useful lubrication property by solid

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lithium silicate is *inherent* to a bearing seal *made from a steel sheet coated with a solid lithium silicate film* because Tsutsui, et al. discloses the usage of lithium silicate solutions as a means for providing suitable lubrication during the forming operations of steel sheets. See lines 16 to 28 in column 2.

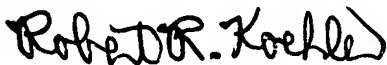
In addition, the presently claimed bearing seal prepared by using a steel sheet treated with a lithium silicate film would obviously have been present once the Tsutsui, et al. product is provided. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977), as to the providing of this rejection made above under 35 U.S.C. § 102.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Robert Koehler whose telephone number is **(571) 272-1536**. The Examiner can normally be reached on Tuesday to Friday from 9:30 AM to 7:00 PM. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on **(571) 272-1535**. The official Fax No. is **(571) 273-8300**, and the After-Final Fax No. is **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).



ROBERT R. KOEHLER
PRIMARY EXAMINER

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October 26, 2005